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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,607	03/15/2004	Hiroshi Yasuda	116692005400	8412

25227 7590 06/17/2009

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EXAMINER	
TRAN, QUOC A	

ART UNIT	PAPER NUMBER
2176	

MAIL DATE	DELIVERY MODE
06/17/2009	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROSHI YASUDA
and TOMOHIKO BEPPU

Appeal 2009-002092
Application 10/799,607[1]
Technology Center 2100

Decided:[2] June 17, 2009

Before LEE E. BARRETT, JEAN R. HOMERE, and JOHN A. JEFFERY, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] Filed March 15, 2004, titled "System for Processing Handwritten Document and Method for Processing Handwritten Document," which claims the foreign filing priority benefit of Japanese applications filed March 17, 2003.

[2] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1, 3, 5-7, and 9-12. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

The invention

The invention relates to a system and method for processing handwritten documents (Spec. 45; Abstract). In one embodiment, illustrated in Figures 1-7, a person applying for a government document (e.g., a resident's card or other form) can go to a receiving terminal in a store in a store or a government office (multi-function machine 11 in Fig. 1) and request an appropriate application document. After receipt of a service fee, the requested document is retrieved from a database server (9 in Fig. 1) and sent to the receiving terminal, where it is printed. An exemplary document is shown in Figure 4. To ensure that data entered in the application is appropriately displayed in the final document, a document identifier is printed with the document application (mark image 42 in Fig. 4). Then, the handwriting is scanned and recognized by the receiving terminal (input part 37 in Fig. 3). The format of the application document is recognized at the time of reading of the application document (Spec. 18-20). After certification of the applicant's identity (information from IC card reader 14 in Figs. 1 and 3 is sent to a certification server 8 in Fig. 1), the information is transmitted via a network to a local government server (10 in Fig. 1). The

local government server publishes a resident's card as a document, which is published by the receiving terminal. The document may have certain security features as shown in Figure 7. The steps are shown in the sequence diagram of Figure 6.

The claims

Claim 1 is reproduced below:

> 1. A system for processing a handwritten document, comprising:
>
> a receiving terminal configured to acquire handwritten information that is handwritten on a document;
>
> a document receiving terminal configured to receive the handwritten information that is transmitted from the receiving terminal; and
>
> a format storage terminal configured to store a format of the document,
>
> wherein the receiving terminal includes:
>
> a format acquisition part which acquires the format of the document from the format storage terminal;
>
> a printing part which prints the document based on the format acquired by the format acquisition part;
>
> a handwritten information acquiring part which acquires the handwritten information that is handwritten on the document; and
>
> a handwritten information transmitting part which transmits the handwritten information to the document receiving terminal, wherein
>
> the printing part prints identifier information, by which the handwritten information acquiring part identifies the format of the document, with the document.

The references

Tsuji	US 2001/0016856 A1	Aug. 23, 2001
Lerner	US 2004/0172595 A1 (effective filing date Mar. 7, 2000)	Sep. 2, 2004

The rejections

Claims 1 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tsuji.

Claims 3, 5, 6, and 9-12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Tsuji and Lerner.

DISCUSSION

Claims 1 and 7

Issue

Does Tsuji teach the limitation that "the printing part prints identifier information, by which the handwritten information acquiring part identifies the format of the document, with the document"?

Contentions

Appellants argue that Tsuji does not teach the limitation at issue. It is argued that in Appellants' invention, when the application document is printed, a visible mark, which functions as an identifier information for identifying the document, is also printed (Br. 5). It is noted that Tsuji teaches an original form P into which characters are handwritten and an electronic form P' reflecting the entries into the original form P. It is noted

that Tsuji includes a letter Z to serve as a form ID in the original form P. It is argued:

> However, in clear contrast to claims 1 and 7, there is no teaching or suggestion in Tsuji that Z is subsequently displayed or printed as part of the electronic form P'. Claims 1 and 7 require that the identifier information for identifying the format of the document must be printed with the document. A similar requirement is not taught or suggested by Tsuji.

Id. at 6. Appellants note that the Examiner states in the Advisory Action that Tsuji teaches in paragraph 82 printing four crossed lines as a form ID, but argue that "[t]here is no disclosure in the quoted section of Tsuji that the identifier information for identifying the format of the document is printed with the document, as required by claims 1 and 7" (*id.*). Appellants argue that these form IDs are merely substitutes for the letter Z, which is not subsequently displayed or printed in Tsuji's form P' (*id.*).

The Examiner maintains that the letter Z is identifier information, as claimed (Ans. 6).

Appellants reply that "because Tsuji does not print electronic form P' *with* the identifier information as required by claims 1 and 7, Tsuji cannot anticipate claims 1 and 7" (Reply Br. 2).

Appellants further argue for the first time in the Reply Brief that the Examiner erred in finding the coordinate-input device 1 of Tsuji to correspond to the claimed receiving terminal and the PC 2 of Tsuji to correspond to the claimed document receiving terminal. It is argued that "[b]ecause the coordinate-input device 1 of Tsuji — which the Examiner

equates with the claimed receiving device — does not include a format acquisition part and printing part as claimed, Tsuji fails to disclose all of the claimed elements, and thus cannot anticipate claim 1 and claims depending thereon" (Reply Br. 5).

Facts

Tsuji discloses "an electronic-form preparation system which recognizes characters handwritten into a form having a predetermined format to prepare a completed electronic form" (¶ [0001]).

Tsuji discloses that "[a]n identifying character may be printed beforehand in the form to identify a form type of the form" (¶ [0018]).

Tsuji discloses:

> The form has a form ID (identification) printed on a predetermined area thereof to identify its form type. This enables entering a form ID without requiring the user to confirm a form ID of the form.

¶ [0043].

Tsuji discloses, in Figure 6, a form P into which characters are written by an input pen and a form P' which represents an electronic form reflecting the entries into form P and either displayed or printed (¶ [0068]).

Tsuji discloses that the letter Z preprinted at the upper left hand corner on form P in Figure 6 serves as an identification ID of the form P (¶ [0069]). The letter Z is traced by the input pen and recognized by the character recognition program (¶ [0070]).

Tsuji discloses that "format data of the electronic form P' corresponding to the recognized letter Z is read from the form-format database 2*c* to specify the format of the electronic form P' by the number boxes, the size of each box, layout of the boxes, etc. included in this format data" (¶ [0073]).

Analysis

We interpret the limitation that "the printing part prints identifier information, by which the handwritten information acquiring part identifies the format of the document, with the document," consistent with the Specification, to refer to printing identifier information on the application form that will be filled in by handwriting and that the identifier is acquired during the handwriting recognition operation to identify the document for preparation of the final form. The limitation does *not* require printing identifier information on the final document as argued by Appellants. Under our interpretation of the claims and disclosure, the letter Z on the form P to be filled out in Tsuji is identifier information by which the handwriting information acquiring part identifies the format of the document (e.g., ¶ [0073]); this letter does *not* have to be on form P' as argued by Appellants.

Our interpretation of the claims is supported by the Specification and the plain claim language. The Specification describes that the identifier information is printed on the application document before the document is filled out (e.g., Spec. 15: 17 through 16: 2, referring to mark image 42 in Fig. 4; Spec. 16: 15-20). This identifier information corresponds to the letter

Z identifier in Tsuji on form P, where it is noted that Tsuji acquires the Z identifier using character recognition (¶ [0070]) and uses that identifier to identify the format of the document (¶ [0073]). Appellants' identifier does not appear on the final document in Figure 7, nor would there be any reason for identifier information, since it is used to format the final document. The claim limitation, "the printing part prints identifier information, by which the handwritten information acquiring part identifies the format of the document, with the document," indicates that the identifier is used to identify the format by the handwritten information acquiring part and says nothing about being printed in the final document. Thus, Appellants' arguments that Tsuji does not teach "the printing part prints identifier information, by which the handwritten information acquiring part identifies the format of the document, with the document" because the Z identifier does not appear on form P' is not supported by the claim language.

Tsuji teaches the limitation that "the printing part prints identifier information, by which the handwritten information acquiring part identifies the format of the document, with the document."

We do not find Appellants' argument in the Reply Brief that the Examiner erred "[b]ecause the coordinate-input device 1 of Tsuji — which the Examiner equates with the claimed receiving device — does not include a format acquisition part and printing part as claimed, Tsuji fails to disclose all of the claimed elements, and thus cannot anticipate claim 1 and claims depending thereon" (Reply Br. 5) in the main brief. It appears that the Examiner's position in the Examiner's Answer is unchanged from the Final

Rejection, and thus, Appellants' arguments presented for the first time in the Reply Brief are untimely. *Cf. Kaufman Co., Inc. v. Lantech, Inc.*, 807 F.2d 970, 973 n.* (Fed. Cir. 1986); *McBride v. Merrell Dow and Pharms*, Inc., 800 F.2d 1208, 1210-11 (D.C. Cir. 1986) ("We generally will not entertain arguments omitted from an appellant's opening brief and raised initially in his reply brief. . . . Considering an argument advanced for the first time in a reply brief, then, is not only unfair to an appellee, but also entails the risk of an improvident or ill-advised opinion on the legal issues tendered.") (internal citations omitted).

Nevertheless, without waiving our position that Appellants waived this argument by failing to make it in their main brief, we note that the Examiner referred to the whole system of Tsuji as teaching the receiving terminal (Ans. 3), and did not just rely on the coordinate-input device 1. Furthermore, Appellants apparently do not contest that Tsuji performs the steps of acquiring a format and printing, because Appellants do not make the same arguments as to method claim 7. Thus, Appellants implicitly acknowledge that Tsuji has a format acquisition part and a printing part, just that it is not in the coordinate-input device 1, as allegedly stated by the Examiner. Even if the Examiner had mistakenly stated that the receiving terminal only corresponded to the coordinate-input device 1, the rejection is over Tsuji as a whole, and Appellants have not shown that Tsuji does not have a format acquisition part and a printing part.

Accordingly, the rejection of claims 1 and 7 is affirmed.

Claims 3, 5, 6, and 9-12

Appellants do not argue the separate patentability of the dependent claims, but argue that the claims should be patentable for the reasons stated with respect to independent claims 1 and 7 (Br. 7). Therefore, the patentability of these claims stands or falls with claims 1 and 7. *See* 37 C.F.R. § 41.37(c)(1)(vii). Because we affirm the rejection of claims 1 and 7, the rejection of claims 3, 5, 6, and 9-12 is affirmed.

CONCLUSION

The rejections of claims 1, 3, 5-7, and 9-12 are affirmed.

Requests for extensions of time are governed by 37 C.F.R. § 1.136(b). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

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